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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------------|------------------|
| 10/561,764 | 08/02/2006 | Xiang-Dong Fu | 00015-049US1/SD2003-244-1 | 9801 |
| 26138 | 7590 | 09/29/2008 | EXAMINER | |
| Gavrilovich Dodd & Lindsey LLP | | | MARTINELL, JAMES | |
| Joseph R. Baker, APC | | | ART UNIT | PAPER NUMBER |
| 8052 Avenida Secreto | | | | 1634 |
| Carlsbad, CA 92009 | | | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 09/29/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/561,764 | FU ET AL. | |
| | Examiner | Art Unit | |
| | James Martinell | 1634 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 December 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/05 & 7/25/06</u> . | 6) <input type="checkbox"/> Other: ____ . |

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The information disclosure statement filed July 25, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The foreign language reference, "AVIVA SYSTEMS BIOLOGY: 'ChiP-GLAS Microarray Technologie'", has not been considered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 22, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 22, and 36 contains the trademark/trade name Cascade Blue™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a dye and, accordingly, the identification/description is indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims -3, 5-17, 19-31, and 33-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wyrick et al (WO 01/16378 (March 8, 2001)). Wyrick et al teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, page 8, line 22 through page 9, line 19, and claim 9. Thus, the instant claims are clearly anticipated by the methods taught by Wyrick et al.

Claims -3, 5-17, 19-31, and 33-36 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wyrick et al (U.S. Patent Application Publication 20080125328). Wyrick et al teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of

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the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, and paragraphs 0007-0010 and 0054-0069. Thus, the instant claims are clearly anticipated by the methods taught by Wyrick et al. Wyrick et al ('328) enjoys an effective filing date of September 1, 1999 because the methods have basis in Serial No. 60/151,972 (*e.g.*, claim 9).

Claims 4, 18, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Wyrick et al (WO 01/16378 (March 8, 2001)) or Wyrick et al (U.S. Patent Application Publication 20080125328) in view of Huang et al (U.S. Patent Application Publication 20010049102). Wyrick et al (WO 01/16378) teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, page 8, line 22 through page 9, line 19, and claim 9. Wyrick et al (U.S. Patent Application Publication 20080125328) teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, and paragraphs 0007-0010 and 0054-0069. Huang et al teaches the amplification of nucleic acids using T3 and T7universal priming sequences (*e.g.*, see paragraph 0046). It would have been obvious for one of ordinary skill in the art at the time the invention was made to use the T3 and T7 priming sequences of Huang et al in the methods of either primary reference for their known and expected function in nucleic acid amplification.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Wyrick et al (WO 01/16378 (March 8, 2001)) or Wyrick et al (U.S. Patent Application Publication 20080125328) in view of Ahern (The Scientist 9 (15), 20 (1995)). Wyrick et al (WO 01/16378) teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, page 8, line 22 through page 9, line 19, and claim 9. Wyrick et al (U.S. Patent Application Publication 20080125328)

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teaches the immunoprecipitation of nucleic acid complexes, the separation of the nucleic acids from the complexes, the amplification of targets in the nucleic acids using universal primers, and the subsequent analysis of the amplified nucleic acids on microarrays. For example, see the Abstract, Figure 1, and paragraphs 0007-0010 and 0054-0069. Ahern discloses the collection of various reagents needed to run biochemical and molecular biological reactions into kits for convenience. It would have been obvious for one of ordinary skill in the art at the time the invention was made to collect any or all of the materials mentioned in either reference for practicing any or all of the methods taught in either primary reference into kit form for convenience as taught by Ahern.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The

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/James Martinell/
Primary Examiner
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